

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/555,105	ALPINI, EDILIO LIVIO	
	Examiner	Art Unit	
	Lynda M Salvatore	1771	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2003.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment, Paper No. 6, has been entered as requested. The specification has been amended to include proper sub-headings and removal of the reference to claim 1.

Claims 1-12 have been amended accordingly and new claim 13 has been added.

2. Applicant's amendment to the specification is sufficient overcome the objections set forth in sections 1-3 of the last Office Action. As such, these objections are withdrawn.

3. Applicant's amendments to claims 1-4 are sufficient to overcome the 35 U.S.C. 112, second paragraph rejections as set forth in sections 6-9 of the last Office Action. As such, these rejections are withdrawn.

### ***Specification***

4. The disclosure is objected to because of the following informalities: In the replacement third paragraph, line 3 is missing the word "fabric" after the word "lattice". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1 and 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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7. Claim 1 is indefinite because it is unclear to the Examiner how the electronic circuit interconnects to the conducting fabric and lattice fabric to “form a closed circuit”.

8. Claim 3 is indefinite because of the term “cross-linked”. The term “cross-linked” implies that the fabric is cured to form molecular cross-links. It is suggested that the Applicant remove the term “cross-linked”.

9. ~~The following is a quotation of the first paragraph of 35 U.S.C. 112:~~

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1 and 3 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended claim 1 to include the limitation of “operably interconnected to said conducting fabric and said lattice fabric to form a closed circuit, wherein said electronic circuit is operable” to dispel an electromagnetic “received at” said garment through a Joule effect. The specification teaches that the lattice fabric serves to close the conductive circuit that has been created in the jacket without a separate electronic circuit (Page 3, lines 30-35, Applicant’s specification), rather than in a separate electronic circuit as presently claimed. With regard to the “received at” limitation, the specification is not commensurate with the scope of claim 1 since the specification teaches that the circuit is operable to disperse the electromagnetic signal *coming* from the jacket rather the “received at” at the jacket as presently claimed (Page 4, lines 16-20, Applicant’s specification). As such, it is the position of the Examiner that this limitation constitutes new matter. With regard to claim 3, the

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Applicant has amended this claim to recite the term “cross-linked”. There is no teaching in the specification that the lattice fabric is cured to produce a “cross-linked” lattice fabric and there is nothing on record to equate “cross-linked” to “criss-crossed”.

***Claim Rejections - 35 USC § 102***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-3 and 7-10 stand rejected under 35 U.S.C. 102 (e) as being anticipated by Banks, US 5,991,922. Applicant’s arguments and amendments with respect to the rejection of claims 1-12 have been fully considered. However, despite this advance the amendments are not found to patently distinguish the claims over the prior art and Applicant’s arguments are found persuasive for reasons set forth herein below.

***Claim Rejections - 35 USC § 103***

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. Claims 4-6 and 11-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Banks, US 5,991,922 as applied to claim 1 above.

15. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Banks, US 5,991,922 as applied to claim 1 above.

Banks fails to teach the claimed specific cutting frequency, however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the cutting frequency value. It has been held that discovering an optimum value of a result effective

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variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215

(CCPA 1980)

***Response to Arguments***

16. With regard to the 102(e) rejections of claims 1-3 and 7-10, the Applicant submits that the claim for foreign priority has been made and perfected and as such, the foreign priority date antedates the 102(e) date of the Banks reference. However, in order to overcome a priority date the foreign document must be English or a certified translation of the foreign document must be submitted. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. Additionally, Banks may still be relied upon since the filing date of Banks CIP, US 5,715,536, precedes the Applicants foreign priority date.

The Applicant also asserts that Banks fails to teach a garment having a circuit “operable to dispel an electromagnetic signal”. It is the position of the Examiner that these limitations constitute a “capable of” limitation. It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ Presently, these claims are only limited to a conducting fabric and lattice fabric comprising an interconnected electronic circuit. Without such positive limitations to the dispelling of an electromagnetic signal it is the position of the Examiner that Banks may be relied upon as reference for teaching a garment comprising conductive material, which is connected to an electronic voltmeter for the purpose of displaying values to the wearer.

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17. With regard to the 103(a) rejections of claims 4-6 and 11-12, these rejections stand since the 102(e) rejections for which these claim rejections are based stand and no new arguments have been presented.

***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

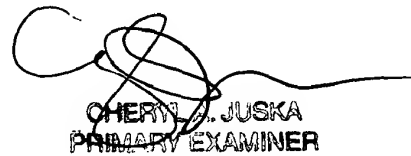
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

ls *JS*  
March 10, 2003

  
CHERYL A. JUSKA  
PRIMARY EXAMINER